

REMARKS/ARGUMENTS

The Office is requiring restriction to one of the following groups:

- Group I: Claims 24-29, drawn to methods for manufacturing metal slurries and ingots from a magnesium alloy to generate crystals; and
- Group II: Claim 30-34, drawn to systems for production of metal plates and ingots.

The Office is also requiring an election of one of the following species:

- Species Ia: a method for manufacturing a metal slurry in a partly molten state by using a tilted cooling body, *i.e.* Claim 24;
- Species Ib: a method for manufacturing a metal slurry in a molten state by using a cooling body, *i.e.* Claim 25;
- Species Ic: methods for manufacturing ingots by introducing molten magnesium alloy into a cooled mold, *i.e.* Claims 26-29.
- Species IIa: a system that includes a tilted cooling body and a cooled mold for production of an ingot (in the mold), *i.e.* Claim 30;
- Species IIb: a system that includes a tilted cooling body for production of a metal plate from a metal slurry (but without a mold), *i.e.* Claim 31;
- Species IIc: drawn to systems that include a cooled mold (but without a tilted cooling body) for production of ingots, *i.e.* Claims 32-34.

Applicants elect, with traverse, Group I, Claims 24-29, for examination. Furthermore, Applicants provisionally elect for examination purposes only, Species Ia, which encompasses at least Claim 24.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP §803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), *i.e.* why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office maintains that Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the Office alleges that the groups lack the same or corresponding special technical features for the following reasons: “claims 30-34 are either obvious over or anticipated by US 6,769,473, upon disclosing the claimed structural features of a melting furnace, (tilted) cooling body, vibrating mechanism, mold, and mold cooling mechanism, with the claimed structural features to form crystals from magnesium alloy as an intended use of the system...”

However, Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), states (with emphasis added):

"The expression “special technical feature” is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, ***considered as a whole***, makes over the prior art. The determination is made on the contents of the claims as ***interpreted in light of the description*** and drawings (if any)."

Applicants respectfully submit that the Office did not consider the contribution of the invention, ***as a whole***, over the disclosure of the cited reference. Applicants also respectfully submit that the Office has not provided any indication that the content of the claims ***interpreted in light of the description*** was considered in making the assertion of a lack of unity. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

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